

REMARKS

Claims 1-33 are pending and at issue in the application with claims 1, 10, 17, 22, 27 and 31-33 being independent claims. Reconsideration and withdrawal of the rejections in view of the remarks below is respectfully requested.

APPLICANTS' INTERVIEW SUMMARY

On January 20, 2006, the applicants' attorney Aaron M. Peters (Reg. No. 48,801) conducted a telephonic interview with Examiner Phuoc H. Nguyen in which the independent claims, the final Office action and the cited references were discussed. Although agreement was not reached with regard to all of the claims, Examiner Nguyen indicated that the accompanying remarks would be considered.

The applicants respectfully traverse the rejections of claims 1-33 as unpatentable over Dodge et al. (U.S. Pat. No. 6,795,778) in view of Swamy et al. (U.S. Pat. No. 6,874,141).

Although the Office action addresses the claim recitations of independent claims 1, 17, 22 and 31-33, the Office action does not specifically address where any of the claim recitations at issue in independent claims 10 and 27 are disclosed in Dodge et al. or Swamy et al. In particular, each of independent claims 10 and 27 recites features and/or claim language different from independent claim 1, as demonstrated by a comparison of the plain language of the claims. It is respectfully submitted that the Office bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of obviousness, and that the Office has not met that burden in the Office action.

The applicants submit that each of claims 1-33 is not obvious over Dodge et al. in view of Swamy et al. The action does not make out a *prima facie* case of obviousness. One of ordinary skill in the art would not modify the system and method of Dodge et al. to exchange documents across business and application boundaries, as taught by Swamy et al., because neither the references nor the prior art suggest the desirability of the combination. See MPEP 2143.01 (I) and (III). Further, the teachings of Dodge et al. and Swamy et al. are not sufficient to render the claims *prima facie* obvious, because the modification proposed in the Office action would change the principle of operation of the system and method of Dodge et al. See MPEP 2143.01 (VI).

In particular, MPEP 2143.01 (I) and (III) require that the prior art must suggest the desirability of the claimed invention. However, the disclosure of Dodge et al. demonstrates that one of ordinary skill in the art would not desire the modification of the system and method of Dodge et al. with the disclosure of Swamy et al. Dodge et al. discloses that communications between a welder and a remote system may be provided in a variety of formats, including XML. (See e.g., col. 4, ll. 28-37; col. 6, ll. 22-27) For example, a communications component 618 of a welder 610 formats information for use by a remote system 640 in a plurality of formats. (Col. 11, ll. 22-39; col. 12, line 62 to col. 13, line 5; Figs. 6 and 7). In other words, the welder 610 initially formats the information in according to the format used by the remote system 640, and there is no need to subsequently map the information to a second, different data format. Accordingly, the system and method of Dodge et al. does not require mapping the information from a source schema to a target schema, as taught by Swamy et al., because Dodge et al. already initially formats the information according to the target schema. As such, the modification of Dodge et al. according to the disclosure of Swamy et al. would not be desirable because it merely introduces a redundant element into the system and method of Dodge et al.

In addition, the motivation provided by the Office action (i.e., to provide businesses to exchange documents across business and application boundaries) does not suggest the desirability of the combination of Dodge et al. and Swamy et al., because the system and method of Dodge et al. does not encounter business or application boundaries which would require the system and method of Swamy et al. During the interview, the Examiner assumed that the various remote entities of Dodge et al. (i.e., the remote system 640, the remote expert data store 650 and the remote service data store 660) were different business partners and therefore encountered the business and application boundaries disclosed in Swamy et al. The Examiner further assumed that the different remote entities required different data formats in order to read and view information provided by the welder 610 and therefore encountered business and application boundaries. However, Dodge et al. does not disclose or suggest that such boundaries are encountered and each assumption made by the Examiner is entirely unsupported by the references.

Although Dodge et al. discloses that the welder 610 may provide information to different remote entities, such as a remote system 640, a remote expert data store 650 and a remote service data store 660, Dodge et al. does not disclose or suggest that the different

remote entities are different business partners as disclosed in Swamy et al. During the interview the Examiner interpreted a "business partner" as including any system coupled to the welder. However, when referring to business partners, Swamy et al. clearly relates to overcoming boundaries established between applications of different businesses and trading partners which may be encountered in business-to-business transactions. (Col. 1, ll. 13-49). However, Dodge et al. does not disclose that the different remote entities 640, 650, 660 are different businesses or trading partners. As such, any interpretation of the remote entities 640, 650, 660 as business partners is entirely inconsistent with the disclosure of Swamy et al. Accordingly, the motivation provided by the Office action does not suggest the desirability of the combination of Dodge et al. and Swamy et al., because Dodge et al. does not encounter boundaries between applications of different business partners as disclosed in Swamy et al.

Further, Dodge et al. does not disclose or suggest that the remote entities 640, 650, 660 require different data formats in order to read and view the information provided by the welder 610. Although Dodge et al. discloses a variety of data formats (e.g., HTML, XML, ASCII text, etc.), Dodge et al. merely discloses that the welder 610 can format the information for use by the remote system 640. (Col. 11, ll. 22-39; col. 12, line 62 to col. 13, line 5). In other words, the different data formats provided by Dodge et al. are merely provided as alternative data formats and does not teach or suggest that the remote entities 640, 650, 660 actually require different data formats. As such, any interpretation of the remote entities 640, 650, 660 as requiring different data formats is an overbroad and unreasonable interpretation of the teachings of Dodge et al. Accordingly, the motivation provided by the Office action does not suggest the desirability of the combination of Dodge et al. and Swamy et al., because Dodge et al. does not encounter business or application boundaries between the welder 610 and the remote entities 640, 650, 660 as a result of different data format requirements among the remote entities 640, 650, 660.

MPEP 2143.01 (VI) further requires that the proposed modification or combination cannot change the principle operation of a reference. However, the modification of Dodge et al. with Swamy et al. as proposed by the Office action would not only introduce a redundant element into Dodge et al. as explained above, but would actually require a substantial reconstruction and redesign of the system and method of Dodge et al. As established above, the welder 610 of Dodge et al. initially formats the information for use by the remote system 640, and does not require any subsequent mapping to a second format. As a result, the

remote system 640 is designed to rely upon the data format initially provided by the welder 610, and basic principle under which the system and method of Dodge et al. operates includes using only a single data format when providing information between the welder 610 and the remote system 640. If the system and method of Dodge et al. were modified as suggested by the Office action, the remote system 640 would no longer be able to read and view the information because the modification introduces a new data format different from the data format relied upon by the remote system 640. Accordingly, the remote system 640, and any other remote system, would require significant modification and reconstruction to its software and/or hardware in order to accommodate the new data format. Alternatively, the welder 610 would require significant modification and reconstruction in order to implement the necessary hardware and software in order to map the information from a first format to a second format, and unnecessarily complicates the system and method of Dodge et al. which initially formats the information for use by the remote system 640 and uses only a single data format when providing the information. Accordingly, Dodge et al. and Swamy et al. are insufficient to establish a *prima facie* case of obviousness because the proposed modification would require a substantial reconstruction and redesign of the system and method of Dodge et al. and change the basic principle under which it was designed to operate.

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The Office action has not established a *prima facie* case of obviousness because the prior art does not suggest the desirability of the combination and because the proposed modification would change the principle of operation of Dodge et al. Accordingly, the rejections of claims 1-33 cannot be maintained.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested. Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application towards allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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